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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/663,029	09/15/2003	Jeff Karn	5887-311US	2560

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AKIN GUMP STRAUSS HAUER & FELD L.L.P.  
ONE COMMERCE SQUARE  
2005 MARKET STREET, SUITE 2200  
PHILADELPHIA, PA 19103-7013

EXAMINER
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RADA, ALEX P

ART UNIT	PAPER NUMBER
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3714

DATE MAILED: 08/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/663,029

Applicant(s)

KARN ET AL.

Examiner

Alex P. Rada

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Drawings*

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the program diagram of claims 11-21 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 10, 20, and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 10, 20, and 29 are indefinite because it is in improper Markush form. It is unclear as to which group(s) applicant considers to be encompassed therein. Alternative expressions are permitted if they present no uncertainty or ambiguity with respect to the question of scope or clarity of the claims. One acceptable form of alternative expression, which is commonly referred to as a Markush group, recites members as being "selected from the group consisting of A, B and C." See *Ex parte Markush*, 1925 C.D. 126 (Comm'r Pat. 1925).

*Claim Rejections - 35 USC § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over 123 Free Solitaire (Golf) in view of Kelly et al (US 5,882,258).

6. 123 Free Solitaire (Golf) discloses the following:

- (a) A deck of cards having a plurality of individual playing cards, each of the individual playing cards having an associated face value (figure 1),
- (b) A playing area within the display (figure 1),
- (c) A first layer of cards of the deck being disposed on the playing area, in which the examiner interprets to the first row of playable cards of figure 1 to be

an equivalent to the first layer of cards of the deck being disposed on the playing area,

(d) A second layer of cards of the deck being disposed on the playing area in overlying relationship to the first layer of cards, at least one card of the second layer of cards partially covering cards of the first layer of cards (figure 1),

(e) A shoe of cards configured to accept cards of the deck that have been selectively removed from the playing area by a player, the shoe being disposed proximate to or within the playing area (figure 1), and

(f) A set of rules dictating scoring of the electronic card game, the rules including,

(i) Selecting cards from the playing area that are not covered by other cards and that have a face value that is one face value higher or one face value lower than the face value of the last card showing in the shoe (figure 3),

(ii) Scoring points based upon a run of play, a run of play being a duration of time when the player can selectively remove cards that are one face value higher or one face value lower than the face value of the last card in the shoe (figure 3),

(iii) Permitting a card in the first layer to become playable when all of the cards of the second layer which were partially covering the card in the first layer have been removed (figure 3), and

(iv) Allowing, in at least some instances, three or more cards in the first layer to become playable when one card of the second layer is removed (figures 1-4) as recited in claims 1, 11, and 22.

The cards have conventional face values including Ace, two, three, four, five, six, seven, eight, nine, ten, Jack, Queen, and King (figures 1-5) as recited in claims 2 and 12.

The cards further include denominations including Hearts, Diamonds, Clubs and Spades (figures 1-5) as recited in claims 3 and 13.

A total score indicator being disposed proximate to or within the playing area, the total score being incremented or decremented based upon the number of cards selected by the player in a run (figure 1) as recited in claims 4, 14, and 23.

The total score is also a function of the amount of time the player takes to select the next playable card (figure 1) as recited in claims 5, 15 and 24.

A plurality of decks of cards forming additional layers in overlying relationship relative to the second layer of cards (figure 1-5) as recited in claims 8, 18, and 27.

123 Free Solitaire (Golf) does not expressly disclose the following:

A wildcard being disposed proximate to or within the playing area and separate from the layers of cards and the shoe, the wildcard being selectable by the player when there are no playable cards that are one face value higher or one face value lower than the face value of the last card in the shoe as recited in claims 6, 16, and 25.

A wildcard being disposed proximate to or within the playing area and separate from the layers of cards and the shoe, the wildcard being selectable by the player at anytime thereby permitting the player to select any playable card as recited in claims 7, 17, and 26.

The cards have a polygonal shape with more than four sides to permit overlying relationship with more than four cards as recited in claims 9 and 19.

The cards have one of a diamond shape, a square shape, a rectangular shape, a circular shape, a pentagonal shape, an octagonal shape, and a non-linear shape as recited in claims 10 and 20.

Kelly et al teaches the following:

A wildcard being disposed proximate to or within the playing area and separate from the layers of cards and the shoe, the wildcard being selectable by the player when there are no playable cards that are one face value higher or one face value lower than the face value of the last card in the shoe (column II, lines 7-40) as recited in claims 6 and 16.

A wildcard being disposed proximate to or within the playing area and separate from the layers of cards and the shoe, the wildcard being selectable by the player at anytime thereby permitting the player to select any playable card (column II, lines 7-40) as recited in claims 7 and 17. By having a wild card feature, one of ordinary skill in the art would provide game players to exercise skill to an enhanced degree in the game.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify 123 Free Solitaire (Golf) to include a wildcard being disposed proximate to or within the playing area and separate from the layers of cards and the shoe, the wildcard being selectable by the player when there are no playable cards that are one face value higher or one face value lower than the face value of the last card in the shoe and at anytime thereby

permitting the player to select any playable card as taught by Kelly to allow a player to exercise skill to an enhanced degree in the game.

At the time the invention was made, it would have been an obvious to a person of ordinary skill in the art to provide any type of card shape since the shape of the card provides the same function as any type of standard playing cards as taught by Kelly because applicant has not disclosed that having a polygon shape, a diamond shape, a square shape, a rectangular shape, a circular shape, a pentagonal shape, an octagonal shape, and a non-linear as recited in claims 9-10, 19-20, and 28-29 provides an advantage or solves a stated problem.

The underlying game of applicant's invention is the same as the cited prior art. The underlying game of applicant's invention is a deck of cards, a playing area, several layers of cards disposed on the playing area, a set of rules dictating scoring of the game, selecting a card from the playing area that is one face value higher or one face value lower than the face value of the last card showing in the shoe, and scoring points based upon a run of play until there is no more possible moves to score. The underlying game of the cited prior art discloses a deck of cards, a playing area, several layers of cards disposed on the playing area, a set of rules dictating scoring of the game, selecting a card from the playing area that is one face value higher or one face value lower than the face value of the last card showing in the shoe, and scoring points based upon a run of play until there is no more possible moves to score. The only difference between the applicant's invention and the cited prior art is the different configuration types of how the cards are laid out on a display.



*Conclusion*

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

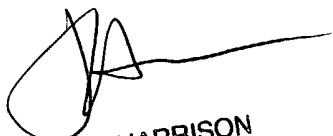
Halliburton `229, Ringo `715, Luciano `214 and `970 and Falciglia `927 all disclose different types of interactive computer game system like solitaire.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alex P. Rada whose telephone number is 703-308-7135. The examiner can normally be reached on Monday - Friday, 08:00-16:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's primary, Jessica Harrison can be reached on 703-308-2217. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
APR

  
JESSICA HARRISON  
PRIMARY EXAMINER